



Docket Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

21.1927

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed
name _____

Application Number

09/337,737

Filed

June 22, 1999

First Named Inventor

Yoji ISHIDA

Art Unit

3628

Examiner

Nga B. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number **41,307**☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Mehdi D. Sheikerz

Typed or printed name

(202) 434-1500

Telephone number

September 5, 2006

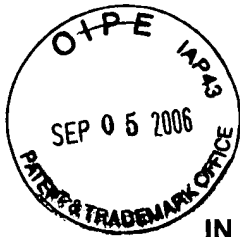
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒*Total of **3** forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Serial No. 09/337,737

Docket No.: 21.1927

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Yoji ISHIDA, et al.

Serial No. 09/337,737

Group Art Unit: 3628

Confirmation No. 9339

Filed: June 22, 1999

Examiner: Nga B. Nguyen

For: ELECTRONIC CASHING CARD SETTLEMENT SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Attention: **MAIL STOP AF**
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

This is a "pre-appeal brief request for review" filed concurrently with a Notice of Appeal appealing final rejection of claims 1-23 and 36. A Petition for a Third Month Extension of Time, together with the requisite fee, is enclosed thereby extending the response due date to September 5, 2006 (September 3 and 4, 2006 falling on a Sunday and a Federal Holiday).

If there are additional fees associated with this filing, please charge the same to our Deposit Account No. 19-3935.

REMARKS

Claims 1-23 and 36 are pending. The independent claims are 1, 10, 17 and 36.

Claims 1-23 and 36 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Van De Pavert (U.S. Patent No. 5,914,471), in view of Boyer et al. (U.S. Patent No. 6,208,973), and further in view of Yanagihara et al. (U.S. Patent No. 6,370,517).

An After Final Amendment was filed on July 27, 2006 presenting arguments that Boyer and Yanagihara do not meet the limitations of independent claims 1, 10, 17 and 36. In the July 27, 2006 After Final Amendment, the independent claims 1, 10 and 17 were not amended, and independent claim 36 was only amended to require a limitation of other independent claims. The Advisory Action of August 25, 2006 only checked box 11 that request for reconsideration has been considered but does not place the application in condition for allowance. However, the Advisory Action does not check any boxes regarding the amended claim 36, but it appears that

the Advisory Action has entered the July 27, 2006 After Final Amendment amended claim 36 for purposes of appeal. Clarification of the Advisory Action and status of claim 36 is requested.

A pre-appeal brief panel review of the identified appealable issues I and II is requested:

I. Clearly claimed present invention's limitation of "**authentication balance**" and "**non-authentication balance**" on an "**electronic cashing card**" is not met by Boyle, because Boyle clearly appears to refer to two account balances at a financial institution (see column 7, line 6, discussing "Generally, the healthcare balance carries a favorable interest rate"), but not on a card (e.g., see July 27, 2006 After Final Amendment at the paragraph spanning pages 9-10, and page 10 complete paragraphs 1-4).

Van De Pavert discusses "a method of recording usage data of a card-operated device, such as a public telephone set or a vending machine. In particular, usage data, such as totaled charges, is stored in a storage unit associated with the device" (Abstract). In Van De Pavert's FIG. 2, clearly the card 1, including the memory 10 that has a counter 15 and a register 17, fails to disclose the claimed present invention's, "**an electronic cashing card having a non-authentication processing memory**" and "**an authentication processing memory.**" The final Office Action page 5 acknowledges that Van De Pavert does not explicitly disclose storing two balances on the card, but the final Office Action relies on Boyer in column 7, lines 1-10.

Boyer column 7, lines 1-10 in part discusses "The cobranded payment card preferably carries two balances, one for standard transactions (retail, travel, entertainment, etc.) and one for healthcare purchase (doctors, hospitals, pharmacies, optical, dental, etc.) ..." However, Boyer FIG. 3, step 100, discusses issuing a cobranded healthcare/payment card to a patient. Therefore, although Boyer column 7, lines 1-5 refers to the card carrying two balances, it is clear that Boyer refers to two account balances at a bank, which differs from the claimed present invention's "**an electronic cashing card having a non-authentication processing memory and an authentication processing memory**" to store "**an authentication balance**" and "**a non-authentication balance.**" The claimed present invention's "**authentication balance**" has "**a requirement for a personal authentication.**" In other words, Boyer is silent on providing "**non-authentication processing memory**" and "**non-authentication processing memory**" on an "**electronic cashing card**" to store on the card "**an authentication balance**" and "**a non-authentication balance.**"

It is submitted that Boyer fails to reasonably suggest to one skilled in the art according to the preponderance of evidence burden of proof for providing two processing memories on an electronic card to store electronic money balances. MPEP 2123 and 37 CFR 1.56.

Further, Boyer is a nonanalogous prior art by failing to be related to an electronic cashing card. And further, Boyer fails to be reasonably pertinent to transaction security using an electronic cashing card. MPEP 2145-IX.

Boyer's card clearly fails to support any suggestion, or motivation to one skilled in art to be combined with Van De Pavert or to modify Van De Pavert, to achieve the claimed invention. Clearly a prima facie case of obviousness cannot be established based upon Boyer.

II. Clearly the claimed present invention's limitation of "***comparing the non-authentication balance and the authentication balance and determining that an illegal process has been performed*** with the card ***when the non-authentication balance is larger than the authentication balance***" is not met by Yanagihara's card usage limit (e.g., see July 27, 2006 After Final Amendment at the paragraph spanning pages 10-11 and page 11 complete paragraph 1. The Office Action page 5 appears to acknowledge that Van De Pavert and Boyer do not disclose this claimed feature, but the Office Action relies on Yanagihara column 5, lines 10-60 to meet this claim language.

Yanagihara column 1, lines 34-63 discusses "an electronic money card, in which a storage section of the card has an area for storing a restricting condition for the withdrawal of electronic money and in which a logic is provided so that a user is allowed to read or write the electronic money stored in the electronic money card based on such condition." Therefore, Yanagihara discusses setting usable limits of electronic money that users of the card can withdraw on a user basis. Yanagihara, FIG. 6 discloses usable limits for regular usage (213) and usage 1 (217) and usage 2 (221) - see column 3, lines 11-30 and column 5, lines 10-60). The Office Action relies on Yanagihara column 5, lines 10-60, which in part discuss "Then, the amount of money withdrawn is added to the aggregate amount of electronic money so far paid 214, 218 or 222 (Step 408), and the obtained sum is compared with both the electronic money balance and the usable limit 213, 217 or 221. If the sum is equal to or smaller than the balance and the usable limit 213, 217, or 221, the user is permitted to make payment in electronic money." However, the comparison in Yanagihara refers to obtaining an amount of electronic money 208 withdrawable from the electronic money card 106 within the usable limit 213, 217 or

221 and comparing the obtained amount with both the electronic money balance and the useable limit 213.

Therefore, the claimed element “**comparing the non-authentication balance and the authentication balance and determining that an illegal process has been performed with the card when the non-authentication balance is larger than the authentication balance,**” is clearly not present in Yanagihara’s comparison and is not included in the Examiner’s analysis, because according to the claimed present invention “**non-authentication balance**” is compared with the “**authentication balance**.” The “**authentication balance**” is a balance of electronic money on the card “**having a requirement for a personal authentication,**” which differs from Yanagihara’s usage limit comparison. Further, Yanagihara fails to discuss anywhere “**updating the non-authentication balance to an amount less than or equal to the stored authentication balance when the transaction is settled by the authentication process.**”

According to 37 CFR 1.56(b)(ii), “a prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification ...” It is submitted that under a broadest reasonable construction, the claimed present invention’s “**comparing the non-authentication balance and the authentication balance ...**,” is patentable over a combined system of Van De Pavert, Boyer and Yanagihara, because clearly Yanagihara’s usage limit differs from the claimed “**non-authentication balance**” of **electronic money on the card**, to which the “**authentication balance**” is compared. In contrast to Yanagihara’s usage limit, the claimed present invention’s “**non-authentication balance**” of **electronic money on the card**, as expressly provided by the language of the claims, is updatable by “**updating the non-authentication balance to an amount less than or equal to the stored authentication balance when the transaction is settled by the authentication process.**” In other words, the Office Action modification motivation is improper, because Yanagihara fails to disclose, either expressly or implicitly, or suggest to one skilled in the art to be modified when combined with Van De Pavert to change its usage limit 213, 217 or 221 based upon a settled transaction.

Although, the claimed present invention’s “**comparing the non-authentication balance and the authentication balance**” can provide a benefit of a usage limit for the card, the claimed present invention achieves the transaction security in a different manner than Yanagihara. Yanagihara fails to reasonably suggest to one skilled in the art according to the preponderance

of evidence burden of proof for providing a usage limit based upon the claimed present invention's **"non-authentication balance" and "authentication balance"** of electronic money on a card - MPEP 2123 and 37 CFR 1.56.

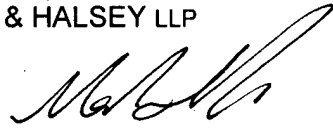
Yanagihara's on a user basis usage limit discussion fails to disclose, or support any suggestion or motivation to one skilled in art to modify Van De Pavert and Boyer, to achieve the claimed present invention's **"updating the non-authentication balance to an amount less than or equal to the stored authentication balance when the transaction is settled by the authentication process"** and **"comparing the non-authentication balance and the authentication balance and determining that an illegal process has been performed with the card when the non-authentication balance is larger than the authentication balance."** For example, the present Application FIG. 5, SP44, FIG. 6A, SP63, FIG. 7A, and page 15, line 6 to page 16, line 16 support the claimed invention.

According to the foregoing, the final Office Action and the Advisory Action clearly err by failing to establish a prima facie case of obviousness over Yanagihara with Van De Pavert and Boyer, because clearly the following limitations are not met by the references: (1) Boyer's card and the claimed **"authentication balance"** and **"non-authentication balance"** on an "electronic cashing card," (2) Yanagihara's **"usage limit"** and the claimed present invention's **"non-authentication balance,"** (3) the claimed present invention's comparison vs. Yanaghiara's comparison, and (4) the claimed present invention's **"updating the non-authentication balance to an amount less than or equal to the stored authentication balance when the transaction is settled by the authentication process"** - and, thus, failing to show a proper modification motivation concerning the same. See also, July 27, 2006 After Final Amendment at p. 12, and December 1, 2005 Response at pp. 11-12.

Withdrawal of the rejection of pending claims is respectfully requested.

Respectfully submitted,
STAAS & HALSEY LLP

Date: September 5, 2006

By: 
Mehdi D. Sheikerz
Registration No. 41,307

1201 New York Ave, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501